

### **REMARKS**

After the foregoing Amendment, claims 3-5, 8-9, 15-18 and 20-27, as amended, are pending in this application. Claims 8, 15, and 21-23 have been amended to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-2, 6-7, 10-14 and 19 have been canceled. Claims 26 and 27 are new. Applicant submits that no new matter has been added to the Application.

### **Telephone Interview**

Applicant wishes to thank the Examiner for the courtesy of the telephone interview conducted on September 6, 2005 in which Applicant's attorney of record explained the previously provided Proposed Amendment including amendments to independent claims 15, 21 and 22. In the interview the Examiner indicated that the amendments would likely overcome the anticipation rejection over Skladman et al. but indicated a new search would be required.

### **The Claimed Invention**

The claimed invention is an e-mail server which alerts a user to the receipt of an e-mail message meeting a user defined predetermined criteria without the user having to first log into the server. The e-mail server alerts the user(s) with an annunciator and a visible counter affixed to the sever. The annunciator provide users in the proximity of the e-mail server with a visible or aural alert. The counter provides an indication of the number of e-mails in the user's mailbox. Each user may set a custom criteria by entering the criteria into a web page generated by the e-mail server.

### **Rejection - 35 U.S.C. § 112**

The Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 8 to depend from claim 21. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112 rejection of claim 8.

**Rejection - 35 U.S.C. § 102**

The Examiner rejected claims 3-5, 8, 9, 13, 15-18 and 20-25 as being unpatentable over U.S. Patent No. 6,400,810. Applicant respectfully traverses the rejection.

**Claims 3-5, 8-9 and 21**

Applicant has amended independent claim 21 to recite a method for alerting a user to the receipt in an e-mail server of an e-mail where the server has affixed thereto, an annunciator and a visible counter such that the annunciator is activated if a text string in an e-mail message received in a user's mailbox meets a predetermined outcome criteria and the count in the visible counter is altered to correspond to the number of e-mail messages stored in the user's mailbox.

Skladman et al. discloses an e-mail system which broadcasts e-mail notices to respective subscribers via preselected ones of a plurality of communication channels including the Internet, voice mail, cellular phone, pager and telephone. Skladman et al. does not disclose an annunciator affixed to an e-mail server which alerts a user to an e-mail message that meets a predetermined criteria or a visible counter affixed to the e-mail server that keeps a count of the number of messages stored in a user's mailbox.

Applicant submits that Skladman et al. does not anticipate claim 21. Accordingly Applicant respectfully requests reconsideration and withdrawal of the §102 rejection of claim 21.

Further, it is respectfully submitted that since claim 21 has been shown to be allowable, claims 3-5 and 8-9 dependent on claim 21 are allowable, at least by their dependency. Accordingly, for all the above reasons, Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection of claims 3-5 and 8-9.

**Claim 22 and 23-25**

Applicant has amended independent claim 21 to recite e-mail server in a housing comprising, a memory, an annunciator and a visible counter affixed to the housing and a

processor. The memory includes program code for execution by the processor. The code includes code for: (1) generating a web page which accepts outcome criteria and instructions and (2) processes e-mail messages to alter the count in the visible counter to correspond to the number of messages in the mailbox and to activate the annunciator.

Skladman et al. discloses an e-mail system which includes an e-mail server and a notification server in which the notification server broadcasts e-mail notices to respective subscribers via preselected ones of a plurality of communication channels including the Internet, voice mail, cellular phone, pager and telephone. Skladman et al. does not disclose an annunciator affixed to the housing of the e-mail server. Further, Skladman et al. does not disclose a visible counter affixed to the housing that keeps a count of the number of messages stored in a user's mailbox. Also, Skladman et al merely describes a software program executing on a personal computer which generates a menu driven interface to select message attributes and notification priority flags (col. 3, lines 48-57) and does not disclose code which executes in the e-mail server, and which generates a web page for configuring the e-mail server by accepting configuration information into the web page.

Applicant submits that Skladman et al. does not anticipate claim 22. Accordingly Applicant respectfully requests reconsideration and withdrawal of the §102 rejection of claim 22.

Further, it is respectfully submitted that since claim 22 has been shown to be allowable, claims 23-25 dependent on claim 22 are allowable, at least by their dependency. Accordingly, for all the above reasons, Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection of claims 13 and 23-25.

#### **Claims 15, 16-18 and 20**

Applicant has amended claim 15 to recite a method for setting outcome criteria and instructions in an e-mail server having an attached annunciator, where the method includes the step of generating in the e-mail server, a web page which accepts the outcome criteria and the outcome instructions, including an instruction for activating the annunciator.

Skladman discloses an e-mail system which includes an e-mail server 18, an e-mail client 20 and a notification server 26. The notification server 26 provides users with a notification that an e-mail message has been received by the e-mail server. The notification server is provided with a filter list containing attributes and flags for determining the priority with which messages are to be notified to the subscriber. However, neither the e-mail server nor the notification server have an attached annunciator as recited in claim 15. Nor does Skladman et al. disclose a web page which executes in the e-mail server and which accepts outcome instructions for activating an annunciator, as recited in claim 15. Applicant submits that Skladman et al. does not anticipate claim 15. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §102 rejection of claim 15.

Further, it is respectfully submitted that since claim 15 has been shown to be allowable, claims 16-18 and 20, dependent on claim 15, are allowable, at least by their dependency. Accordingly, for all the above reasons, Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection of claims 16-18 and 20.

#### **New claims 26 and 27**

New claims 26 and 27 each recite an e-mail server which accepts an instruction specifying whether the annunciator output should be steady or interrupted. Skladman et al. merely discloses notification consisting of spoken messages, fax messages and text messages (col. 6, lines 8-37) and does not disclose an instruction for specifying whether an annunciator output should be steady or interrupted. Further, it is respectfully submitted that since claims 15 and 22 have been shown to be allowable, claims 26 and 27, dependent respectively on claims 15 and 22, are allowable, at least by their dependency. Accordingly, for all the above reasons, Applicant respectfully requests allowance of new claims 26 and 27.

Application No. 10/020,409  
Reply to Office Action of July 5, 2005

**CONCLUSION**

Insofar as the Examiner's rejections have been addressed, the application is in condition for allowance and Notice of Allowability of claims 3-5, 8-9, 15-18 and 20-27 is therefore earnestly solicited.

Respectfully submitted,

**KENNETH J. WILSON**

October 4, 2005  
(Date)

By:

LOUIS SICKLES II

Registration No. 45,803

**AKIN GUMP STRAUSS HAUER & FELD LLP**

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

**Direct Dial: 215-965-1294**

Facsimile: 215-965-1210

E-Mail: lsickles@akingump.com

LS/lcd